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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

USGINZ00130

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on August 20, 2010 (VIA EFS)

Signature

Typed or printed name Quyen Nguyen (VIA EFS)

Application Number

10/797,485

Filed

March 9, 2004

First Named Inventor

Vahid SAADAT

Art Unit

3739

Examiner

Matthew J. Kasztejna

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 45,565

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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August 20, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Date: August 20, 2010

Signature:  (Quyen Nguyen)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/797,485
Confirmation No.: 3298
Filing Date: March 9, 2004
Inventor(s): Vahid SAADAT et al.
Title: ENDOLUMINAL TOOL DEPLOYMENT SYSTEM
Examiner: Matthew J. Kasztejna
Group Art Unit: 3739

REASONS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Final Office Action mailed February 23, 2010, in the above-identified United States Patent Application. Filed herewith is a Notice of Appeal and fee, and a petition and fee for a three month extension of time. The Commissioner is authorized to charge any other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **USGINZ00130**.

A pre-appeal brief review is requested for the reasons set forth below.

INTRODUCTION

The present application relates generally to an endoscopic apparatus that is used, for example, to access and manipulate tissue in the body of a patient via a natural body orifice or a laparoscopic port. Embodiments of the apparatus include an elongated main body having first and second independently shape-lockable and/or steerable sections and a variety of instruments that are either built into the main body or that are advanceable through lumens that extend through the main body. The ability to steer and shape-lock

specific sections of the main body enables access to target locations within the body of the patient that are typically challenging to reach and provides a stabilized platform to perform a desired procedure at the target location.

Exemplary embodiments of the endoscopic apparatus are shown in the figures reproduced at right. The apparatus includes an elongated main body 10 having a shaft 20 defining a central lumen 23, and a plurality of lumens 24, 26, 28 extending through the central lumen 23 (see FIG. 2A). The shaft 20 is a single tube that may include first, second, and third longitudinal sections 90, 92, 93 (see FIG. 8E). In an embodiment, the first section 90 is flexible, the second section 92 is shape-lockable, and the third section 93 is steerable relative to the second section 92.

One or more sections of the shaft 20 may incorporate a plurality of nested links 260 (see FIG. 9B), which include pullwires 96 extending through pullwire lumens 98. The pullwires 96 are used to hold the elements 260 in a nested alignment and to provide steering and locking. In FIG. 7B, an apparatus 10 is shown advanced through the esophagus E and into the stomach S of the patient. The distal section is steered to a target location where tool arms 30 carrying tools 40 are advanced through lumens of the main body. For example, an endoscope 28 may be advanced through the endoscope lumen 26 to exit at the distal end of the main body.

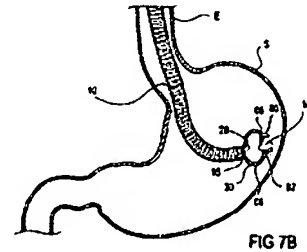


FIG 7B

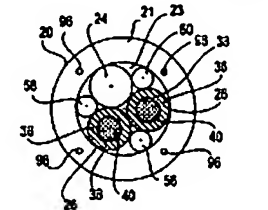


FIG 2A

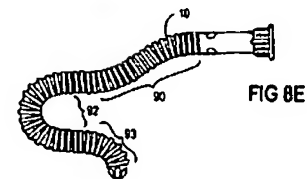


FIG 8E

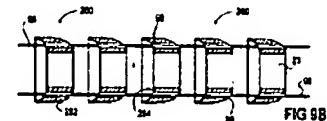


FIG 9B

ISSUES ON APPEAL

At issue are: (a) whether claims 67-71, 73-74, 76-80, 82-83, and 95-96 should be rejected under 35 U.S.C. § 102(b) as being anticipated by USP 5,251,611 to Zehel et al. ("Zehel"), and (b) whether claims 84, 92, and 94 should be rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehel in view of USP 3,897,775 to Furihata (as to claim 84), or over Zehel in view of USP 5,916,147 to Boury (as to claims 92 and 94).

ARGUMENT

I. Rejections of Claims 67-71, 73-74, 76-80, 82-83, and 95-96

Claims 67-71, 73-74, 76-80, 82-83, and 95-96 were rejected as being anticipated by the Zehel patent. Appellant traverses these rejections because: (a) Zehel fails to teach or disclose all of the elements of the foregoing claims, and (b) for those elements that are disclosed by Zehel, the patent fails to show the elements arranged or combined in the same way as they are recited in the claims.

Claim 67 recites an apparatus that includes, *inter alia*,

- an elongated main body ***“comprising a single tube”*** with a first (proximal) section having a plurality of nested links and a second (distal) section being ***“steerable relative to the first section,”***
- a tensioning mechanism for imparting a tension force on pullwires extending through the nested links of the first section to switch the first section from a flexible to a rigid condition, and
- a scope extended through a lumen in the main body and being ***“movable through said lumen.”***

The Zehel patent, on the other hand, describes two embodiments of a flexible steerable exploratory device, each of which includes an elongated shaft having an inner conduit 10 and an outer conduit 11. One or both of the inner and outer conduits 10, 11 may be made rigid along its entire length. (Zehel, col. 4, ll. 4-20). In the first embodiment, shown in FIG. 1, the device includes a steerable distal end 12. (Col. 4, ll. 33-39). The distal end 12 also optionally includes one or more other instruments for conducting a variety of procedures. (Col. 5, ll. 48-58). In the second embodiment, shown in FIGS. 7-8, the device does not include the steerable distal end, instead having an elastic membrane 40 enclosing the outer conduit 11 and inner conduit 10. (Col. 9, ll. 12-28). The second embodiment optionally includes “standard endoscopic devices” or their component parts occupying the center section 29 of the device, or the second embodiment “can be an add-on device for an existing endoscope.” (Col. 10, ll. 20-29).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, in

order to anticipate, a prior art reference must not only disclose all elements of the claim within its four corners, but it must also disclose those elements “arranged as in the claim.” See Net MoneyIn, Inc. v. Verisign, Inc., 545 F.3d 1359, 1370 (Fed. Cir. 2008).

Neither of the device embodiments disclosed in the Zehel patent is sufficient to establish a prima facie case of anticipation of claim 67. The first embodiment, shown in FIG. 1, does not include an elongated main body “comprising a single tube,” nor does the embodiment include “a scope extended through” the main body lumen with the scope “being movable” through the lumen. Zehel’s first embodiment includes, instead, an elongated main body made up of inner and outer conduits, and a “vision aperture” that is housed in the distal end of the main body. For at least these reasons, there can be no anticipation of claim 67 by the first embodiment device described in the Zehel patent.

The Zehel second embodiment, shown in FIGS. 7-8, also does not include an elongated main body “comprising a single tube.” Instead, the second embodiment device includes inner and outer conduits. The second embodiment also does not include a second section of the main body that is “steerable relative to the first section.” For that matter, the second Zehel embodiment also does not teach or disclose a second section of the main body that is located distally of the first section such that the pullwires are “fixed to the elongated main body at a location at or near a distal end of the first section.” For at least these reasons, there can be no anticipation of claim 67 by the Zehel second embodiment.

Significantly, even if the two Zehel embodiments were combined, the combination still would not anticipate claim 67 because each of the embodiments includes a main body having inner and outer conduits, rather than the “single tube” recited in claim 67. Combining these discrete embodiments – or isolated teachings from those embodiments – also would be improper as a basis for showing anticipation because Zehel does not disclose the elements “arranged as in the claim.” See Net MoneyIn, 545 F.3d at 1370.

Accordingly, Appellant respectfully submits that the rejections of claims 67-71, 73-74, 76-80, 82-83, and 95-96 as being anticipated by Zehel must be withdrawn.

II. Rejections of Claims 84, 92, and 94

Claim 84 was rejected as being unpatentable over the combination of Zehel and Furihata, and claims 92 and 94 were rejected as being unpatentable over the combination of Zehel and Boury. Appellant traverses these rejections for the following reasons.

First, claims 84 and 94 both depend from claim 67, which is patentable over Zehel for the reasons presented in Section I above. Neither of the Furihata and Boury patents corrects the deficiencies of the Zehel patent discussed above. For these reasons, there can be no prima facie case of obviousness of either of claims 84 or 94 based upon these combinations of references.

As for claim 92, that claim recites an apparatus that includes, inter alia, a shaft “comprising a single tube” having first and second sections each made up of a plurality of links, pullwires extending through the first section and a steering wire extending through both the first and second sections, a working lumen extending through the shaft, and a scope movably extended through the working lumen. As noted above, neither of Zehel’s two disclosed embodiments includes all of the foregoing highlighted limitations from claim 92. Nor does Boury correct these deficiencies. For example, Boury does not teach a scope “extended through” a lumen in the main body, or that such a scope is “moveable through” the lumen. For at least these reasons, there can be no prima facie case of obviousness of claim 92.

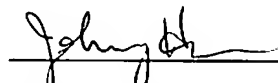
CONCLUSION

In view of the foregoing, the Application is in condition for allowance. The rejections of the pending claims set forth in the Final Office Action should be withdrawn and the claims passed to issue.

Respectfully submitted,

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